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PATENT
Attorney Docket No.: 020366-074300US

TOWNSEND and TOWNSEND and CREW LLP

By: Kay Barclay

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Arnold M. Lund, et al.

Application No.: 09/596,973

Filed: June 20, 2000

For: SHARING FUNCTIONS
BETWEEN A TELEVISION-BASED
INFORMATION APPLIANCE AND
REMOTE CONTROL DEVICES

Customer No.: 20350

Confirmation No. 6256

Examiner: BUI, KIEU OANH T.

Technology Center/Art Unit: 2623

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed concurrently herewith for the above-referenced application, Appellants submit this Brief on Appeal.

1. REAL PARTIES IN INTEREST

Qwest Communications International Corporation is the real party in interest as the assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-10, 21-26, and 33 are currently pending in the application. All pending claims stand rejected pursuant to an Office Action mailed January 23, 2007 ("Office Action"). The Office reopened prosecution from Appeal for a second time.

Appellants first filed a first Notice of Appeal on November 29, 2004, and filed a Brief in Support thereof January 31, 2005. The Office reopened prosecution in that instance, rejecting the claims pursuant to a Final Office Action mailed June 29, 2005 ("Final Office Action"). On August 29, 2005, Appellants requested that the Appeal be reinstated for the first time, and filed a Brief in Support of the Appeal. However, the Office again reopened prosecution with the Office Action on January 23, 2007.

The rejections of claims 1-10, 21-26, and 33 are believed to be improper and are the subject of this appeal.

4. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Office Action or Final Office Action pursuant to which prosecution was reopened on Appeal.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellants have provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as

required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only.

Methods and systems are disclosed which allow a user to select where caller identification information is to be displayed. In the embodiment of claim 1, an information system is disclosed which comprises a display 14 and a video source sending video to be displayed on the display 14. Application, p. 3, ll. 5-14; Fig. 1, ref. nums. 12, 14. A remote generates a wireless signal for controlling the video source. Id., p. 4, ll. 8-9, p. 5, ll. 14-15; Fig. 1, ref. nums. 16, 18, 30, 32. The remote includes a caller identification display for displaying caller identification information and at least one of a microphone or a speaker for telephone communication. Id., p. 5, l. 18 - p. 6, l. 2; Fig. 3, ref. nums 76, 78. The information system also comprises a menu 140 to be displayed on the display. Id., Fig. 5, ref. num. 140. The menu includes a plurality of options for a user to select one or more locations to display caller identification information. Id., p. 7, ll. 9-15. One of the options comprises displaying the caller identification information on the remote. Id.

In the embodiment of claim 2, which depends from claim 1, the remote is a wireless keyboard 18. Id., p. 3, l. 15.

In the embodiment of independent claim 21, a method for operating an information system including a display and a remote includes displaying video on the display. Id., p. 3, ll. 5-14; Fig. 1, ref. nums. 12, 14; p. 7, ll. 16-17. An option is provided to display caller identification information on the display. Id., p. 7, ll. 9-15. A second option is also provided to display caller identification information on the remote. Id. A user selection to display the caller identification information on a selected one of the display or the remote is received. Id., p. 7, ll. 19-20. The method also includes determining that a telephone call is incoming to the information system. Id., p. 7, ll. 20-21. Caller identification information is received from the incoming call and the caller identification information is displayed on the selected one of the display or the remote. Id.

In the embodiment of claim 33, a remote input device for an information system is disclosed comprising at least one user input device, a transmitter, a receiver, and a display.

Id., p. 3, ll. 5-15; p. 5, ll. 19-20; Fig. 1; Fig. 3. The transmitter generates a wireless signal for controlling an information system component based upon activation of the user input device. Id., p. 3, ll. 13-18. The receiver receives a wireless signal including caller identification information received from a telephone system. Id., p. 3, ll. 13-15; p. 5, ll. 18-20. The remote display displays caller identification information received via the transceiver based on a user option configuring the display location of the caller identification information. Id., p. 7, l. 18 - p. 8, l. 4.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground of Rejection I: Claims 1, 3-10, 21-26, and 33 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,505,348 to Knowles et al. (hereinafter "Knowles") in view of U.S. Patent No. 5,671,267 to August et al. (hereinafter "August").

Ground of Rejection II: Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Knowles in view of August and U.S. Patent No. 6,292,172 to Makhoulf (hereinafter "Makhoulf").

7. ARGUMENT

Ground of Rejection I:

Whether claims 1, 3-10, 21-26, and 33 are obvious over Knowles in view of August

Claims 1, 3-10, 21-26, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of August. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP § 2143. Applicants believe significant limitations from independent claims 1, 21, and 33 are neither taught nor suggested in the references. Appellants respectfully submit that the §103(a) rejection to these claims be withdrawn.

Claims 1, 3-10: Claim 1 recites an information system including a display, a remote, and a menu to be displayed on the display. The menu includes a plurality of options for a user to select one or more locations to display caller identification information. One of the

options comprises displaying caller identification information on the remote. Neither Knowles, nor August, disclose a menu providing an option selectable to display caller ID information on the remote.

The Office Action relies on Fig. 23 of Knowles, which illustrates a screen stating "Caller ID Setup. Select how you want the Caller ID pop-up to be displayed." Knowles, col. 24, ll. 1-2; Fig. 23. Knowles then specifically shows the caller ID setup screens in Figs. 24 and 25. Id., col. 24, ll. 10-21; Figs. 24, 25. This passage of Knowles, and Figs. 24 and 25, allow a user to control 1) whether the on screen caller ID display pop-up is on or off, and 2) the duration of the caller ID display screens. This passage of Knowles makes it quite clear that pop-up at issue is "on this TV." Id., col. 24, ll. 15, 24; Figs. 24, 25. But a menu controlling the display of caller ID information on screen is very different than a menu giving a user an option to display caller ID information on a remote.

An earlier passage in Knowles sets forth a "pop-up that displays over a TV state or any guide screen" Id., col. 22, ll. 62-63. It is evident that this guide screen is on the TV, as Knowles is specifically directed at providing on screen guides for television. There is simply no suggestion that a menu in Knowles provide a user the option to display a caller ID off of the TV screen, and no teaching that the user has the option to select for the caller ID to be displayed on the remote.

August discloses a handset unit which provides normal wireless communications with a cordless telephone base unit. August, col. 1, ll. 29-31. The handset unit also provides two-way remote control functions for interacting with devices, such as a video receiving device or set-top box. Id., col. 1, ll. 31-39. While a telephone is ringing, the number of a calling party may be displayed on the video receiving device and/or the display of the handset unit. Id., col. 10, ll. 29-33. But there is no suggestion that the particular location of the calling number is a user-selectable option. Additionally, August fails to disclose a menu which includes options for the user to select location(s) to display caller identification information.

The cited references appear to provide no teaching or suggestion that the location of the caller ID display is a user-selectable option. Moreover, it is evident that there is no option

to select an option to have the caller ID to be displayed on the remote. They, therefore, fail to teach or suggest the recitations of claim 1 discussed above. As the cited references fail to teach or suggest all of the recitations of claim 1, Appellants submit that claim 1 is allowable. Claims 3-10, which depend from claim 1, are allowable for at least the same reasons. Therefore, Appellants respectfully request the rejections to claims 1 and 3-10 be reversed.

Claim 21-26: Claim 21 recites a method for operating an information system including a display and a remote. The method includes "providing an option to display caller identification information on the display" and "providing a second option to display caller identification information on the remote." Thus, claim 21 provides for two options: 1) an option to display caller ID information on the video display, and 2) an option to display caller ID information on the remote. This second of two options is clearly not taught or suggested in Knowles.

As discussed with reference to claim 1, Knowles and August both fail to teach or suggest providing a menu option to display caller identification information on a remote. Accordingly, both references also fail to teach or suggest the additional recitation of claim 21 of "receiving a user selection to display the caller identification information on a selected one of the display or the remote."

As the cited references fail to teach or suggest all of the recitations of claim 21, Appellants submit that claim 21 is allowable. Claims 22-26, which depend from claim 21, are allowable for at least the same reasons. Hence, Appellants respectfully request the rejections to claims 21-26 be reversed.

Claim 33: Claim 33 recites a remote device including a display. The display displays caller identification information based on a user option configuring the display location of caller identification information.

As previously discussed with respect to claim 1, Knowles and August fail to teach or suggest a user option for configuring the display location of caller ID information. As noted above, Knowles only appears to provide a menu for an on/off option for the *on TV screen* caller

ID pop-up, and control of the duration of the caller ID display *on the TV screen*. There is no suggestion of a display on a remote that displays caller ID information based on the selection of that location by the user.

As the cited references fail to teach or suggest all of the recitations of claim 33, Appellants submit that claim 33 is allowable. Hence, Appellants respectfully request the rejections to claim 33 be reversed.

Ground of Rejection II:

Whether claim 2 is obvious over Knowles and August in view of Makhoulf.

Claim 2 depends from claim 1. As previously discussed, Knowles and August fails to teach or suggest the recitations of claim 1 of a menu including options for a user to select location to display caller identification information. More specifically, neither reference discloses a menu providing an option selectable to display caller ID information on the remote.

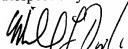
Makhoulf also fails to teach or suggest these recitations. In fact, Appellants can find no teaching or suggestion in Makhoulf of any type of menu with user-selectable options. As acknowledged by the Examiner, August also fails to disclose a menu with user options.

As the cited references fail to teach or suggest all of the recitations of claim 2, Appellants submit that claim 2 is allowable. Appellants respectfully request the rejection to claim 2 be reversed.

Conclusion

Appellants believe that the above discussion is fully responsive to all grounds of rejection set forth in the application. It is believed that no fee is required for filing the Notice of Appeal or this Appeal Brief, as the previously paid Notice of Appeal fee and Appeal Brief fee may be applied. Should the Patent Office determine otherwise, however, please deduct the requisite fee from Deposit Account 20-1430.

Respectfully submitted,



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8. APPENDIX

The claims pending in the application are as follows:

1. (Previously Presented) An information system comprising:
a display;
a video source sending video to be displayed on the display;
a remote generating a wireless signal for controlling the video source, the remote including a caller identification display for displaying caller identification information and at least one of a microphone and a speaker for telephone communication;
a menu to be displayed on the display, the menu including a plurality of options for a user to select one or more locations to display caller identification information, one of the options comprising displaying the caller identification information on the remote.
2. (Original) The information system of claim 1 wherein the remote is a wireless keyboard.
3. (Original) The information system of claim 1 wherein the remote selectively generates a wireless signal for changing the video to the display.
4. (Original) The information system of claim 1 wherein the remote includes the microphone and the speaker.
5. (Original) The information system of claim 1 further including a telephone base unit in wireless communication with the remote.
6. (Original) The information system of claim 5 wherein the telephone base unit is in communication with a telephone network.
7. (Original) The information system of claim 1 wherein the video source is a subscription television decoder.

8. (Original) The information system of claim 1 wherein the video source is a main unit providing video and telephone communication.

9. (Original) The information system of claim 8 wherein the main unit includes a subscription television decoder.

10. (Original) The information system of claim 9 wherein the main unit includes an internet connection.

11-20. (Canceled)

21. (Previously Presented) A method for operating an information system including a display and a remote, the method including the steps of:

- a) displaying video on the display;
- b) providing an option to display caller identification information on the display and providing a second option to display caller identification information on the remote;
- c) receiving a user selection to display the caller identification information on a selected one of the display or the remote;
- d) determining that a telephone call is incoming to the information system;
- e) receiving caller identification information from the incoming call; and
- f) displaying the caller identification information on the selected one of the display or the remote.

22. (Original) The method of claim 21 further including the step of transmitting the caller identification information to the remote prior to said step f).

23. (Original) The method of claim 22 wherein said step f) further includes the step of displaying the caller identification information on the remote.

24. (Original) The method of claim 21 further including the step of controlling the video on the display by sending a wireless signal from the remote.

25. (Previously Presented) The method of claim 21, further comprising:
a) changing the video on the display with a wireless remote; and
b) communicating on the telephone call via an audio transducer on the remote.

26. (Previously Presented) The method of claim 25 further including the steps of:

- a) providing an option to provide communication via the audio transceiver on the remote or an audio transceiver on the display; and
- b) receiving a selection of one of the remote or display in response to said providing the option; and
- c) communicating on the telephone call via the selected one of the audio transceiver on the display or the remote.

27-32. (Canceled)

33. (Previously Presented) A remote input device for an information system comprising:

- at least one user input device;
- a transmitter for generating a wireless signal for controlling an information system component based upon activation of the at least one user input device;
- a receiver for receiving a wireless signal including caller identification information received from a telephone system; and
- a display for displaying the caller identification information received via the transceiver, wherein the display displays the caller identification information based on a user option configuring the display location of the caller identification information.

9. EVIDENCE APPENDIX

None

10. RELATED PROCEEDINGS APPENDIX

None